APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/925,259	08/09/2001	Jonathan William Adams	AUS920010647US1	4214

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EXAMINER
NGUYEN, TAN D

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 04/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

Office Action Summary	Application No.	Applicant(s)
	09/925,259	ADAMS ET AL.
	Examiner	Art Unit
	Tan Dean D. Nguyen	3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 December 2005*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☐ All   b)☐ Some * c)☐ None of:

　　　　1.☐ Certified copies of the priority documents have been received.

　　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
　　Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
　　Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

U.S. Patent and Trademark Office

PTOL-326 (Rev. 7-05)　　　　　　　　Office Action Summary　　　　　　Part of Paper No./Mail Date 20060320

DETAILED ACTION

Response to Amendment

1.   The amendment filed 12/15/05 is objected to under 35 U.S.C. 132(a) because it

introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment

shall introduce new matter into the disclosure of the invention. The added material

which is not supported by the original disclosure is as follows: In claims 18-20, the

language "and plurality of patterns ... guide" are new issues not supported in the

original disclosure. The examiner has reviewed the case but has not found support for

these language.

    Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 101

2.   35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
conditions and requirements of this title.

3.   **Claims 18, 19, 20, 1-8, 9, 10-17 are rejected under 35 U.S.C. 101 because the**

claimed invention is directed to non-statutory subject matter.

    (1) In order for the claimed invention to be statutory subject matter, the claimed

invention must fall within one of the four statutory classes of invention as set forth in §

101 (i.e. (1) a process, (2) machine (apparatus), (3) manufacture (article of

manufacture), or (4) composition of matter).

    (2) In the present case, method claim 18 is directed to a "method for designing

an architecture for an e-business solution", which is not within one of the classes of

invention set forth in § 101.

(3) The "method for designing an architecture for an e-business solution"

comprising the steps of:

(a) developing a business description of the e-business solution;

(b) developing a pictorial representation of the business description; and

(c.) establishing a plurality of patterns within the pictorial representation, the

patterns being indicative of various implementations of the business description

whereby the pictorial representation and plurality of patterns serve as a guide for

designing the architecture of the e-business solution",

(4) are merely a disembodied abstract idea and do not produce a (1) useful and

(2) tangible, and (3) concrete result. The result of the instant invention is one or more

patterns (graph or trend) displayed on a contextual visualization interface. The patterns

(graph or trend) might be considered "useful" in designing an architecture for an e-

business solution. However, § 101, 2nd test requires that the result be reproducible or

repeatable to meet the tangible and concrete requirement. See *In re Swartz*, 232 F.3d

862, 864, 56 USPQ2d 1703, 1704 (Fed. Circuit 2000). In the instant case, it's not clear

how the most important step (c.) as well as other steps (a) and (b) are carried out?

There is no citation in the specification of how these steps are carried out and no

example has been cited. Applicant's response of 12/15/05, on page 15, that the

examiner appears to be holding the applicants to an impromptu and extrajudicial

standard of patentability is not sufficient to overcome the rejection.

(5) The claim is broad to include carrying out steps (a)-(c.) by human being which

produces results which are subjective and irreproducible, in other word, each person

would have his own distinctive description and pictorial presentation and patterns since

this depends on his background, culture, or environment. This fails to meet the test that

the result has to be <u>concrete</u> to meet the § 101 test. Moreover, there is no physical

transformation of anything to another state or thing even though this is dispositive.

Therefore, claim 18 is thus drawn to the abstract idea of designing an architecture for an

e-business solution, rather than to a practical application of the idea as required by 35

U.S.C. § 101.

Similarly, method claims 1-8, which have similar limitations as in claim 18, are

rejected for similar reasons as cited above.

Similarly, program product claims 20, 10-17, system claims 19 and 9, which carry

out the method claims 18 and 1 respectively, are rejected for the same reasons set forth

in claim 18 and 1 above.

Claim Rejections - 35 USC § 112

4.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of
> making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the
> art to which it pertains, or with which it is most nearly connected, to make and use the same and shall
> set forth the best mode contemplated by the inventor of carrying out his invention.

5.   **Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to**

comply with the enablement requirement.

The claim(s) contains subject matter which was not described in the specification

in such a way as to <u>enable</u> one skilled in the art to which it pertains, or with which it is

most nearly connected, to <u>make and/or use</u> the invention, without undue

experimentation. The claim fails to include at least one example, or demonstration to

show how the method of claim 1 or 18 works. For example, what and how steps (a) or (b) or (c) are carried out and how (c.) is carried out to fulfill the scope of the claim which is "designing an architecture for an e-business solution". Can applicant cite an example or summary of the logic of how claim 1 or 18 work? The examiner has read the specification at least twice and has no clear understanding of what are the claimed invention. The examiner has give this case to another examiner who has a degree in MIS and an MBA and this examiner has the same problem. The specification merely explains the language of the claims but contains no examples of how the inventions work as a whole from steps (a) to (c.).

Similarly, program product claims 20, 10-17, system claims 19 and 9, which carry out the method claims 18 and 1 respectively, are rejected for the same reasons set forth in claim 18 and 1 above.

Upon reviewing the specification, especially page 18, lines 8-27, it appears that a computer software such as architecture design program Fig. 7B (171) is needed to implement the flowchart 10 (Fig. 1) which is the scope of the claimed invention. In other word, an architecture design program Fig. 7B (171) is needed to implement the claimed invention or claims 1, 9, 10, 18, 19 and 20. What is the architecture design program and how does it work? Is it a specific program known by the inventor alone? How does one person of ordinary skill figure out which one of the many available architecture design program out there to use and how to implement it in the current invention without undue experimentations?

6.   Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject

matter which applicant regards as the invention.

1) In claim 18, line 7, the phrase "whereby the pictorial representation and

plurality of patterns serves as a guide" is vague. The term "serves" should be corrected

to "serve". It's not clear what this phrase means "the patterns being indicative of various

implementations of the business description whereby the pictorial representation and

plurality of patterns serve as a guide for designing the architecture of the e-business

solution". Applicant needs to cite an example of what this means.

2) Claims 19-20 are rejected for the same reasons set forth in claim 1 above.

3) In claim 1, it's not clear the relationship between the four cited patterns and

how they are connected to produce a method for designing an architecture for an e-

business solution, as shown in the preamble of the claim.

4) It 's not clear how dep. claim 8 (part of 1) further limits claim 1, for example,

what step?

5) Claim 9 (apparatus to carry out method claim 1) is rejected for the same

reason set forth in claim 1 above.

Claim Rejections - 35 USC § 102

7.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8.   **Claims 10-17, 20 are rejected under 35 U.S.C. 102(e) as being anticipated by**

CALVER (US 2001/0032092).

As for independent computer program product claims 10, 20, CALVER

discloses a computer program product in a computer readable medium {see claims 21,

31}. As for the rest of the limitations in claims 10-17, 20, they have no patentable since

there are no citation in the claim that "the computer readable code when being executed

by a processor (computer) causing said computer to perform the method of (a), (b), and

(c.)". In other word, there are no computer connected to the code or involved in the

body of the claim to carry out the method steps, so these are merely code.

As for dep. claims 11-17 (part of 10), they are rejected for the same reasons set

forth in claim 10 above.

Claim Rejections - 35 USC § 103

9.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

10.   Claims **18, 19, 1-8, 9** are rejected under 35 U.S.C. 103(a) as being

unpatentable over CALVER in view of GRYPHON et al (US 6,233,537).

As for independent method[1] claim 18, GRYPHON et al discloses a workflow

modeling of business applications composed of multiple plan elements having pictorial

representation and business rules or models (patterns) to control the business

application/actions {see Figs. 1-5, col. 3, lines 1-37, col. 5, lines 60-67}}. GRYPHON et

al fairly teaches the claimed invention except for dealing business application

concerning e-business solution. CALVER is cited to teach a method for designing an

architecture/format for an e-business solution to provide the benefits of providing

valuable financial, marketing, and business development information to small business

{see [0016, 0003, 0010, 0052, 0054, 0081]}. It would have been obvious to modify the

teachings of GRYPHON et al by including application dealing e-business solution as

taught by CALVER for at least one of the benefit cited above.

As for independent apparatus[1] claim 19, which is an apparatus to carry out the

method of claim 18 above, "means for " instead of "step of", it is rejected for the inherent

apparatus to carry out the method steps of 18 by GRYPHON et al /CALVER above.

As for **independent method[2] claim 1**, which is similar to method claim 18

above with more specific business patterns establishing steps, these are fairly taught in

GRYPHON et al Figs. 7A-10. As for the different types of patterns or models, these

depend on the type of business functions, symbols and intended users, as shown on

Table I, col. 4. and would have been obvious to a skilled artisan to apply them if desired.

As for dep. claims 2-8 (part of 1 above), the further implementations of steps (a)

– (c) of claim 1 above, which depends on each specific business application, types of

desired business descriptions, types of desired business pictorial representations, types

of business patterns, etc., and the selection of various combinations of these

parameters would have been obvious to a skilled artisan since they depend on desired

applications.

As for **independent apparatus[2] claim 9**, which is an apparatus to carry out the

method of claim 1 above, "means for " instead of "step of", it is rejected for the inherent

apparatus to carry out the method steps of 1 by GRYPHON et al /CALVER above.

Response to Arguments

11.   Applicant's arguments filed 12/15/05 have been fully considered but they are not

persuasive.

(1) With respect to the 101 rejections, the rejection of the claims for not meeting

the "technological arts" test is withdrawn due to the *Ex Parte Lundgren* decision.

However, the current claims do no meet the "useful, concrete and tangible" test as cited

above.

(2) With respect to the 112, 1st paragraph, applicants' response is insufficient to

overcome the rejection since applicant has not shown/demonstrated how the

specification is clearly described in a way that enables one skilled in the art to make

and/or use the invention. Applicants have not cited an example of how the claimed

invention or method claim 1 or 18 works. The specification merely recites the language

of the claim several times with some sporadic related ideas. Applicants' amendment of

claims 18-20 are solely to clarify the invention but these amended claims are still

insufficient to overcome the rejections.

(3) With respect to the 112, 2nd paragraph, applicants' comment that the

definiteness of the language is analyzed, not in a vacuum, but in light of the teachings of

the disclosure as the disclosure would be interpreted by one of ordinary skill in the art,

and no citation or example of how the claim is carried out is needed, this is not found

persuasive for the same argument as indicated above, how the specification is clearly

described in a way that enables one skilled in the art to make and/or use the invention.

(4) With respect to the 102(e) rejections of claims 10-17 as anticipated by Calver,

the rejection is maintained because there are no citation in the claim that "the computer

readable code when being executed by a processor (computer) causing said computer

to perform the method of (a), (b), and (c.)". In other word, there are no computer

connected to the code or involved in the body of the claim to carry out the method

steps, so these are merely code, thus having no patentable weight.

(5) With respect to the 103(a) rejections of claims 18, 19, 1-8, 9, applicant's

comment that CALVER /GRYPHON et al fails to teach the establishing of patterns

(models) within the pictorial representation, this is not found persuasive in view of

GRYPHON et al, col. 3, lines 5-10, "*graphical notation* *that can be used to represent*

business process knowledge and the corresponding business information that

comprises the business model.", col. 6, under "How to use Visual BML", col. 9, line 62 to

col. 10, lines 16. Note that the rejections are based on CALVER /GRYPHON et al and

not GRYPHON et al alone. Applicants' comment that CALVER is merely cited to teach

the computer readable code is not correct.

(6) Upon reviewing the specification, especially page 18, lines 8-27, it appears

that a computer software such as architecture design program Fig. 7B (171) is needed

to implement the flowchart 10 (Fig. 1) which is the scope of the claimed invention. In

other word, an architecture design program Fig. 7B (171) is needed to implement the

claimed invention or claims 1, 9, 10, 18, 19 and 20. What is the architecture design

program and how does it work? Is it a specific program known by the inventor alone?

How does one person of ordinary skill figure out which one of the many available

architecture design program out there to use and how to implement it without undue

experimentations?

Conclusion

12.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

    1) U.S. Patent 5,819,267 is cited to teach method and apparatus for know-how

    management.

    2) U.S. Patent 5,940,817 is cited to teach method and apparatus for problem

    solving.

    3) US 6,385,609 is cited to teach system and method for analyzing and

    displaying report output.

    No claims are allowed.

13.   Information regarding the status of an application may be obtained from the
Patent Application Information Retrieval (PAIR) system. Status information for
published applications may be obtained from either Private PAIR or Public PAIR.
Status information for unpublished applications is available through private PAIR only.
For more information about the PAIR system, see http://pair-direct@uspto.gov. Should
you have any questions on access to the private PAIR system, contact the Electronic
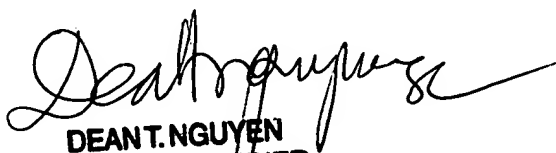Business Center (EBC) at 866-217-9197 (toll free).

        In receiving an Office Action, it becomes apparent that certain documents are
missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for
copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or
e-mail CustomerService3600@uspto.gov .

        Any inquiry concerning the merits of the examination of the application should be
directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule
is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off
every other Friday.

        Should I be unavailable during my normal working hours, my supervisor John
Weiss can be reached at (571) 272-6812.
        The main FAX phone numbers for formal communications concerning this
application are (571) 273-8300. My personal Fax is (571) 273-6806. Informal
communications may be made, following a telephone call to the examiner, by an
informal FAX number to be given.

dtn
April 15, 2006

DEAN T. NGUYEN
PRIMARY EXAMINER